



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/989,683 | 11/21/2001 | Richard Ormson | 016778-0439 | 9711 |

22428 7590 01/03/2006

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

SOBUTKA, PHILIP

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2684

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,683

Applicant(s)

ORMSON ET AL.

Examiner

Philip J. Sobutka

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-22 is/are allowed.
- 6) ☒ Claim(s) 1,4,5 and 10 is/are rejected.
- 7) ☒ Claim(s) 2,3,7-9 and 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. Claims 1,4,10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior et al (US 6,349,220) in view of Beaton (US 6,608,637).

Consider claim 1. Prior teaches a mobile communications device comprising a main display area and a keypad (Prior fig 6 b, item 63), and a touch sensitive area to allow selection of the functions by contact, (Prior fig 6a item 60). Note that Prior's main display area is never used as a touch sensitive area, the user inputs using the touch sensitive area on the back corresponding to the area on the front display (Prior col 4, lines 48-65). Prior lacks a teaching of the touch sensitive area on the back also displaying the one or more function keys. Beaton teaches a touch sensitive input which displays one or more of the input functions (Beaton see especially figs 2,7, col 6, lines 18-44). It would have been obvious to one of ordinary skill in the art to modify Prior to use a touch sensitive display in order to indicate to the user which functions would be activated without having to turn the phone around to look at the main display.

As to claims 4, note that Prior's device is a mobile telephone (Prior see especially fig 1, col 1, lines 3-5).

As to claim 10, note that Prior's functions vary depending on what is being displayed (Prior col 4, lines 55-65).

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prior in view of Beaton and in view of Barvesten (US 6,714,802).

As to claim 5, Prior in view of Beaton teaches everything claimed as shown above, except for the mobile telephone device being a WAP mobile telephone. Barvesten teaches that use of the WAP protocol allows browsing the internet (Barvesten see especially col 6, lines 1-15). It would have been obvious to one of ordinary skill in the art to modify Prior in view of Beaton to use the WAP protocol in order to allow the user to browse the Internet.

Allowable Subject Matter

3. Claims 15-22 are allowed.
4. Claims 2,3,7,8 and 9,11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Consider claims 3,7,8, 11, 15,19. The nearest prior art as shown in Beaton fails to teach the device of claim 1, wherein the touch sensitive area has a mask or label to show the one or more user input options as separate keys.

As to claim 2, the nearest prior art as shown in Prior and Beaton fail to teach the device of claim 1 where the main display area and the touch sensitive display area are each part of a single display.

Response to Amendment

5. Applicant's arguments with respect to claims 1,4,5,10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Sobutka whose telephone number is 571-272-7887. The examiner can normally be reached on Monday - Friday, 8:30am - 5:00pm.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882.

10. The central fax phone number for the Office is 571-273-8300.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Sobutka
(571) 272-7887

EDAN ORGAD
PATENT EXAMINER/TELECOMM.

EP. 12/23/07